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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/991,389	11/21/2001	Stuart Ozer	14531.151	5411

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EXAMINER

SANTOS, PATRICK J D

ART UNIT	PAPER NUMBER
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2171

DATE MAILED: 06/08/2004

2

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/991,389

Applicant(s)

OZER ET AL

Examiner

Patrick J Santos

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 November 2001.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-48 is/are pending in the application.
4a) Of the above claim(s) 19-48 is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-18 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 21 November 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-18, drawn to a transmitter of advertisements, classified in class 709, subclass 231.
 - II. Claims 19-31, drawn to a means of selecting advertisements, classified in class 705, subclass 7.
 - III. Claims 32-40, drawn to a random player, classified in class 705, subclass 14.
 - IV. Claims 41-48, drawn to an update loop, classified in class 709, subclass 240.

Restriction of Groups I, II, III, and IV are under combination-subcombination.

Specifically:

- Regarding Group I and Group II:
 - o Note that a transmitter of advertisements, such as that of Group I, need not require a means of selecting advertisements, such that of Group II, but rather may rely on a sequential transmission of data.
 - o Similarly, the output of a means of selecting advertisements, such as that of Group II, need not be a transmitter, such as that of Group I, but may merely be an output report.
- Regarding Group I and Group III:

- Note that transmission of advertisements, such as that of Group I, need not have random playing functionality, such as that of Group III.
- Note that a randomizing algorithm, such as that of Group III, may apply to any processing, not just that of a transmitter, such as that of Group I.
- Regarding Group I and Group IV:
 - Note that that a transmitter of advertisements, such as that of Group I, need not have an update loop, such as that of Group IV, but may merely play a predetermined sequence of data.
 - Note that an update loop, such as that of Group IV, may optimize other processing functions, other than the transmitter of Group I.
- Regarding Group II and Group III:
 - Note that selection algorithm of advertisements, such as that of Group II, need not be randomized by a randomizing algorithm, such as that of Group III.
 - Note that a randomizing algorithm, such as that of Group III, may apply to any processing, not just that of the results of a selection algorithm of advertisements such as that of Group II.
- Regarding Group II and Group IV:
 - Note that selection algorithm of advertisements, such as that of Group II, need not have an update loop, such as that of Group IV, but may merely play a predetermined sequence of data.

- o Note that an update loop, such as that of Group IV, may optimize other processing functions, other than the selection algorithm of advertisements, such as that of Group II.
- Regarding Group III and Group IV: Note that that a randomizing algorithm, such as that of Group III, need not be used in conjunction with an update loop, such as that of Group IV, and vice versa.

During a telephone conversation with Rick Nydegger, attorney of record, on June 2, 2004, a provisional election was made without traverse to prosecute the invention of Group I, Claims 1-18. Affirmation of this election must be made by applicant in replying to this Office action.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

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The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-18 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, from the wording of independent Claims 1 and 11, it is indefinite on whether the claims are in regarding to an apparatus or method claim.

Examiner suggests rewording the claim to read, "...configured to display advertisements to a viewer, and for **executing** a method for delivering advertising content..." (Clm. 1, Ins. 1-2 and Clm. 11, Ins. 2-3).

Dependent Claims 2-10 and 12-18 inherit same deficiency from Claims 1 and 11.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-7, 9, 11-16, and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,721,827 issued to Logan et al. (hereafter Logan '827).

Claims 1 and 11:

Regarding Claims 1 and 11 Logan '827 discloses: a system and a computer program product for implementing a system, including at least one processor, configured to display

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advertisements to a viewer, a method for delivering advertisement content for an advertisement to at least one receiver module for subsequent display to the viewer (Logan '827: Abstract, col. 4, lns. 14-27; col. 2, ln. 67 to col. 3, ln. 18), the method comprising the acts of:

- receiving, at a control module, for each advertisement, a schedule and a location for the display of the advertisement (Logan '827: col. 2, lns. 10-15; col. 5, lns. 20-49; col. 24, lns. 1-4 – additionally note that a download processing, mechanism, Fig 1., Item 151, reads on a control module), an indicator of the advertisement type (Logan '827: col. 24, lns. 20-27 – note Subject Type reads on Advertisement Type), and a weight for the advertisement, the weight (Logan '827: col. 25, lns. 15-20) defining the frequency of display of the advertisement (Logan '827: col. 25, lns. 26-45);
- generating a data file defining, for each advertisement, the advertising type, weight, location, and schedule for display of the advertisement content for the advertisement (Logan '827: col. 5, lns. 37-49; col. 2, lns. 10-23; col. 24, lns. 1-15); and
- upon retrieving the advertisement content for the advertisement, delivering the advertisement content and the data file to at least one receiver module configured to display the advertisement content of the advertisement in accordance with the data file (Logan '827: Fig. 1; col. 24, lns. 13-15 – In Fig. 1, note item 135 (advertising), item 151 (download processing), items 125, 127, and 129 (transmit data), and item 103 (receiver)).

Claims 2 and 12:

Regarding Claims 2 and 12, Logan '827 discloses all the limitations of Claim 1 and 11 (supra). Additionally, Logan '827 discloses: wherein receiving, for each advertisement, the

schedule, the location, the advertising type and the weight comprises receiving from a planning module remote from the control module, for each advertisement, the schedule, the location, the advertising type and the weight (Logan '827: col. 9, ln. 51 to col. 10, ln. 5 – note the user, which reads on a planning module remote from the control module).

Examiner notes that Applicant's planning module enables either an administrator or an individual (which includes a user) for providing advertisement distribution information (Specification: para. [016]).

Claims 3 and 13:

Regarding Claim 3, Logan '827 discloses all the limitations of Claims 2 and 12 (supra). Additionally, Logan '827 does not disclose: wherein receiving, for each advertisement, the schedule, the location, the advertising type and the weight comprises receiving continuously, periodically, or sporadically the schedule, the advertising type, and the weight from the planning module (Logan '827: col. 5, lns. 20-36 – note that Logan '827 supports a wide variety of frequencies of downloading, which reads on support for continuous, periodic, and sporadic updates).

Claim 14:

Regarding Claim 14 Logan '827 discloses all the limitations of Claim 11 (supra). Additionally, Logan '827 discloses: wherein the computer-executed instructions further comprise:

- program code means for defining at least one attribute from at least one of:
 - o a schedule time for the advertisement;
 - o a duration of the advertisement;

- a time zone shift of the advertisement;
 - an indicator of type for the advertisement schedule;
 - a weight of the advertisement;
 - a demographic target for the advertisement; and
 - a display area for the advertisement (Logan '827: col. 5, lns. 37-49; col. 2, lns. 10-24; col. 24, lns. 1-15; col. 24, lns. 20-27; col. 25, lns. 15-20; col. 25, lns. 26-45 – note that in general, the calculation of the weight provides for input from many attributes, and any number and type of attributes are supported as per Logan '827: col. 44, lns. 33-39); and
- program code means for storing the at least one attribute (Logan '827: col. 6, ln. 65 to col. 7, ln. 3; col. 7, lns. 22-25).

Claim 4, 6-7, 9, 16, and 18:

Regarding Claims 4, 6-7, 9, 16, and 18, Logan '827 discloses all the limitations of Claims 1 and 14 (supra). Additionally, Logan '827 discloses:

- (Claim 4) the act of generating the data file comprises the acts of:
 - defining at least one attribute from at least one of:
 - a schedule time for the advertisement;
 - a display area for the advertisement;
 - a duration of the advertisement;
 - a time zone shift for the advertisement schedule time;
 - an indicator of type of the advertisement;
 - a weight of the advertisement; and

- a demographic target of the advertisement; (Logan '827: col. 5, lns. 37-49; col. 2, lns. 10-24; col. 24, lns. 1-15; col. 24, lns. 20-27; col. 25, lns. 15-20; col. 25, lns. 26-45 – note that in general, the calculation of the weight provides for input from many attributes, and any number and type of attributes are supported as per Logan '827: col. 44, lns. 33-39) and
 - storing the at least one attribute at the receiver module (Logan '827: col. 6, ln. 65 to col. 7, ln. 3; col. 7, lns. 22-25).
- (Claims 5 and 15) wherein delivering the advertisement content and the data file comprises:
 - identifying a time when the advertisement content is to be displayed to the viewer (Logan '827: col. 7, lns. 22-45 – note that by virtue of placement of data in the sequence of the Program Sequence File, a time to play is specified (although the viewer may override));
 - identifying a rule stored at the control module, the rule defining when to deliver the advertisement content and the data file (Logan '827: col. 5, lns. 24-27); and
 - based upon the time and the rule, delivering the advertisement content and the data file to the at least one receiver module (Logan '827: col. 5, lns. 20-46).
- (Claims 6 and 16) delivering the advertisement content and the data file comprises delivering the advertisement content and the data file to the at least one receiver module (Logan '827: col. 6, ln. 65 to col. 7, ln. 3; col. 7, lns. 22-25).

- (Claim 7) an individual scheduling the advertisement content defines the advertising impression goal used to define the advertising weight (Logan '827: col. 9, ln. 51 to col. 10, ln. 5; col. 25, lns. 26-45 – note the ChargeLevel parameter reads on an impression goal).
- (Claims 9 and 18) further comprising receiving historical data from the at least one receiver module, the historical data defining the viewing activities of the viewer at the at least one receiver module (Logan '827: col. 5, lns. 50-67; col. 7, lns. 40-45; col. 5, lns. 7-19).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 8 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Logan '827 in view of U.S. Patent No. 6,286,005 to Cannon (hereafter Cannon '005).

Claims 8 and 17:

Regarding Claims 8 and 17, Logan '827 discloses all the limitations of Claims 1 and 14 (supra). Additionally, Logan '827 discloses use of an advertising type (Logan '827: col. 24, lns. 20-27 – note Subject Type reads on Advertisement Type). However, Logan '827 does not

explicitly disclose: wherein the advertising type defines whether the advertising weight is an absolute weight or a relative weight.

Cannon '005 discloses: an advertising weight is an absolute weight or a relative weight (Cannon '005: col. 34, lns. 19-22 (historical data reads on an absolute value); col. 34, lns. 42-45 (indices as described read on a relative value)) .

It would have been obvious to a person having ordinary skill in the art to substitute the advertising type of Logan '827, which is set as subject type, to an indication of absolute and relative weights of Cannon '005. The motivation to combine is suggested by Cannon '005 which discloses the advantages the flexibility of mixing and matching various measures as input to advertising optimization, which would be enabled by indicating the type of weights input into the system (Cannon '005: col. 34, ln. 60 to col. 35, ln. 6).

8. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Logan '827 in view of Applicant Admitted Prior Art (hereafter AAPA).

Claim 10:

Regarding Claim 10, Logan '827 discloses all the limitations of Claim 1 (supra). Additionally, Logan '827 discloses use of an advertising type (Logan '827: col. 24, lns. 20-27 – note Subject Type reads on Advertisement Type). Furthermore, Logan '827 discloses the ability to display advertisements in a committed fashion and a flexible fashion (Logan '827: col. 25, lns. 37-40 – note the distinction between advertising that is prioritized and put into the program schedule, versus advertising that is inserted as filler in order to match the ChargeLevel

proportion). However, Logan '827 does not explicitly disclose: wherein the advertising type defines the advertisement as either a committed advertisement or a flexible advertisement.

AAPA discloses committed advertisement and flexible advertisement (Specification: para. [09]).

It would have been obvious to a person having ordinary skill in the art to substitute the advertising type of Logan '827, which is set as subject type, to an indication of the committed and flexible types as set forth in AAPA. The motivation to combine is suggested by Logan '827 which discloses the advantage of being able to fully fill a program schedule with different priorities of advertising, which would be optimized with an indicator of committed vs. flexible advertising (col. 25, lns. 40-45).

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- U.S. Patent No. 5,999,912, to Wodarz, "Dynamic Advertising Scheduling, Display, and Tracking."
Provides details of web ads, such as positioning.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patrick J.D. Santos whose telephone number is 703-305-0707. The examiner can normally be reached on M-F 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic can be reached on 703-308-1436. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Patrick J.D. Santos
June 4, 2004


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